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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,015	09/30/2003	Masayuki Momiuchi	463P108	4854
42754	7590	07/26/2005	EXAMINER	
NIELDS & LEMACK 176 EAST MAIN STREET, SUITE 7 WESTBORO, MA 01581			NGUYEN, DUNG T	
			ART UNIT	PAPER NUMBER
			2828	

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

11 -- H.A

Office Action Summary	Application No. 10/675,015	Applicant(s) MOMIUCHI ET AL.	
	Examiner Dung (Michael) T. Nguyen	Art Unit 2828	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/02/03</u> <u>12/24/03</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION***Claim Objections***

Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The preamble of an ophthalmological surgical system does not give weight for patentable according to MPEP 2111.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hollemann et al. (US6711184). Fig.1 shows a laser device, comprising a laser beam emitter 1 having an optical resonator (1-3), wherein said optical resonator has a resonator and a reflection mirror 3 (col.5, 1.41-42), and at least one of a length of said resonator is determined so as to satisfy condition that a parameter M2 of beam quality range of a projected laser beam is between 1-10 (col.3, 1.34). It would have been obvious to one having ordinary skill in the art at the time the invention was made to do so because the Hollmann range is overlapping the claim range. And also, by satisfying the beam quality M2 value, it would have been obvious to one having ordinary skill in the art at the time the invention was made to derive the formula of M2 as claimed.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hollemann et al. (US6711184) in view of Ryan et al. (US2003/0195495).

Hollemann disclose all limitations of the claim except for a core diameter of the optical fiber is from 50 um to 75 um, and numerical aperture Naf of said optical fiber is 0.10-0.12.

Ryan teach a core diameter of the optical fiber is 50 um and numerical aperture Naf of said optical fiber is 0.12 (para.0050).

For the motivation of providing a deep penetrating laser beam to the optical fiber (para.0050, 1.11), it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Hollemann what is taught by Ryan.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hollemann et al. (US6711184) in view of Ryan et al. (US2003/0195495) and further in view of the admitted prior art in this application.

Hollemann and Ryan disclose all limitations of the claim except for the exit numerical aperture NAe of the laser beam emitted from said optical fiber is $0.06 \leq \text{NAe} \leq 0.1$.

Admitted prior art teaches $\text{NAe} < \text{Naf}$ (page 2, 1.18). Since, in claim 3, the Naf is 0.12 and therefore the NAe must be less than 0.12.

For the motivation of avoiding the loss of the laser beam projected to the target (for example the eye fundus) can be decreased (page 3, 1.15-17), it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Hollemann and Ryan what is taught by Admitted prior art.

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Communication Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung (Michael) T Nguyen whose telephone number is (571) 272-1949. The examiner can normally be reached on 8:30 - 17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Min Harvey can be reached on (571) 272-1835. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-3329.

Michael Dung Nguyen

Amal B
Examiner
Art Unit 2828